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CENTRAL FAX CENTER

SEP 21 2007

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) DE 020318 | |
|---|--|---|-------------------------------------|
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>9/21/07</u> Signature <u>M Ure</u> Typed or printed name <u>Michael Ure</u> | | Application Number <u>10/538,580</u> | Filed <u>06/15/2005</u> |
| | | First Named Inventor <u>DIETIG</u> | |
| | | Art Unit <u>2817</u> | Examiner <u>JONES, STEPHEN E</u> |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p> | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of
PIETIGAtty. Docket
DE 020318

Serial: 10/538,580

Group Art Unit: 2817

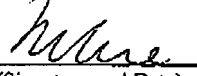
Filed: 06/15/2005

Examiner: JONES, STEPHEN E

NON-RECIPROCAL CIRCUIT ELEMENT

Certificate of Fax/Mailing Under 37 CFR 1.8

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Michael Ure
(Name) 9/21/07
(Signature and Date)

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

RESPONSE—PRE-APPEAL REVIEW

Sir:

The following Remarks are responsive to the Office Action of 08/06/2007.

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DE 020318****Serial: 10/538,580****Group Art Unit: 2817****Filed: 06/15/2005****Examiner: JONES, STEPHEN E****NON-RECIPROCAL CIRCUIT ELEMENT****Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450****RESPONSE—PRE-APPEAL REVIEW****Sir:****The following Remarks are responsive to the Office Action of 08/06/2007.**

REMARKS

The Office Action of 08/06/2007 has been carefully considered. Reconsideration in view of the present remarks is respectfully requested.

Claims 2, 3 and 5 were indicated as containing allowable subject matter, which indication is appreciatively acknowledged.

Claims 1 and 4 were rejected as being unpatentable over Marusawa in view of Maruhashi. This rejection is respectfully traversed and reconsideration respectfully requested.

Maruhashi teaches, in an arrangement having opposed disks of hard magnetic material and soft magnetic material, replacing the disk of soft magnetic material with a disk of hard magnetic material and eliminating the former disk of hard magnetic material. *The disks are formed separately from an assembly in which they are assembled.* (See US Patent 5,419,947 referenced by Maruhashi.)

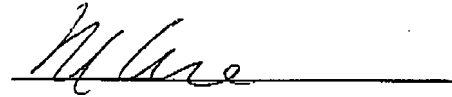
Applying a similar substitution to the primary reference Marusawa would not have been obvious to one of ordinary skill in the art. In particular, neither reference teaches or suggests a specific hard magnetic material suitable for use in the fabrication technique of Marusawa in which the magnetic material would be applied as a sinterable foil in the course of fabrication in like manner as layers of other materials. There is no evidence that such a hard magnetic material, capable of being worked in this manner, would have been known to or readily ascertainable by one of ordinary skill in the art.

To draw an analogy, the bodily insertion of a discrete resistor or discrete capacitor into an integrated circuit would not be obvious—because it is unworkable. The use of

integrated resistors and capacitors in an integrated circuit is obvious because these structures are known. In like manner, the bodily insertion of a separately formed hard magnet into the apparatus of the primary reference would not have been obvious because it is unworkable. Furthermore, there is no teaching of record that a suitable technique for forming a sinterable foil of hard magnetic material was known.

Withdrawal of the rejections and allowance of claims 1-5 is respectfully requested.

Respectfully submitted,



Michael J. Ure, Reg. 33,089

Dated: 09/21/2007